

Response

The claims were amended in accordance with the amendments above. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

In the Office Action date 03/06/2006, claims 39-40, 42, 44-47, 51, 52, 54-58, and 60-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Assisi (US 5,696,488) in view of Bexten (US 6,205,133). Claims 41, 43, 48-50, 53, and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Assisi (US 5,696,488) in view of Bexten (US 6,205,133) and Evans, III (US 5,732,231). Applicant respectfully traverses all rejections.

Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching, suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicant submits that the combined art of record fails to render the amended claims obvious. In particular, Applicant notes that the combination of references fails to teach or suggest all of the limitations of each amended claim in accordance with MPEP 2143.03. In addition, Applicant submits that even if the combined art of record taught or suggested all of the limitations of each present claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a *prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

With respect to amended independent claim 39, Applicant notes that the claim recites an act of providing a life pack to a person associated with the deceased person, wherein the life pack comprises requests for particular types of biographical information relating to the deceased person, and wherein the act of receiving biographical information relating to the deceased person comprises receiving responses to the requests for particular types of biographical information relating to the deceased person from the person associated with the deceased person in response to the act of providing the life pack. Applicant submits that the combined art of record fails to teach or suggest such limitations. Accordingly, the combined art of record fails to render amended independent claim 39 obvious in accordance with MPEP 2143.03, and the rejection should therefore be withdrawn.

With respect to amended independent claim 52, Applicant notes that the claim recites a kiosk located within the cemetery, wherein the kiosk comprises one or more of the computer readable medium, the processor, the receiver, or the transmitter. Applicant respectfully submits that the combined art of record fails to teach or suggest these limitations. Applicant notes that these limitations are similar to those previously recited in claim 59, which has been canceled. In the rejection of claim 59, the Office cited Figs. 2-4; col. 1, ll. 60-63; col. 2, ll. 50-67; and col. 3, ll. 42-67 of Evans III as teaching the claimed kiosk. However, to the extent that Evans III teaches a kiosk, Evans III teaches such a kiosk as being located in a funeral home or other funeral establishment; whereas amended independent claim 39 teaches a kiosk being located in a cemetery. Applicant submits that one of ordinary skill in the art would immediately recognize the differences between a funeral home/establishment and a cemetery; and that Evans III therefore fails to teach or suggest the claimed kiosk located in a cemetery. None of the other prior art references of record make up for this deficiency of Evans III. In short, the combined art of record fails to teach or suggest the combination of a kiosk in a cemetery, a transmitter in a cemetery, a receiver, and the ability of persons located in a cemetery to obtain information relating to a plurality of deceased persons through the receiver and transmitter, as recited in amended independent claim 52. Accordingly,

the combined art of record fails to render amended independent claim 52 obvious in accordance with MPEP 2143.03, and the rejection should therefore be withdrawn.

With respect to amended independent claim 61, Applicant notes that each of those claims contains limitations which are similar to those discussed above with respect to amended independent claim 52. Thus, for at least the reasons set forth above regarding amended independent claim 52, a *prima facie* case of obviousness cannot be established against independent claim 61 in accordance with MPEP 2143.03 based on the art of record. Applicant therefore respectfully requests that the rejection be withdrawn.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the amended claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Instead of showing a proper motivation to combine all of the teachings in the prior art necessary to obtain the presently claimed invention, with such motivation predating the priority date of the present application, the Office instead relies on a subjective opinion by an individual Examiner, rendered more than nine years after the priority date of the present application. Applicant respectfully submits that this constitutes impermissible hindsight reconstruction, and therefore cannot properly constitute the motivation to combine required by MPEP 2143.01.

The absence of a motivation to combine the teachings of the references is further reinforced by the fact that Bexten is non-analogous art with respect to Assisi and Evans III. Applicant respectfully traverses the suggestion by the Office that the cited references “are from the same field of endeavor, presenting information to a user.” This

characterization of the field of endeavor is impermissibly overbroad. See *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (finding the Patent Office's characterization of the field of endeavor impermissibly overbroad). Applicant also notes that the overbroad characterization is impermissibly inconsistent with Applicant's disclosure. See *In re Bigio*, 381 F.2d 1320, 1326 (Fed. Cir. 2004) (admonishing that characterizations of the field of endeavor must be based on the Applicant's full disclosure). Those of ordinary skill in any art would recognize that the teachings of Bexten are in the art of wireless communication network architectures, whereas Assisi and Evans III are in the art of storing and retrieving information related to a deceased person. Because the cited references represent such non-analogous art, and in accordance with MPEP 2141.01(a), it would not have been obvious to one of ordinary skill in the art to combine their teachings. Ultimately, the Office Action fails to provide the requisite *evidence* in the prior art suggesting the desirability of the combinations claimed herein, but instead relies solely on conclusory statements and impermissible hindsight reconstruction, citing non-analogous art. Because the motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

Beyond the foregoing shortcomings with respect to the independent claims, Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.



10/051,555

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully Submitted,

Andrew B. Ulmer (Reg. No. 57,003)
Frost Brown Todd LLC
2500 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202-4182
513-369-4811 (direct)
513-651-6981 (fax)

Certificate of Mailing

The undersigned certifies that this correspondence was deposited with the U.S. Postal Service with sufficient postage as first class mail and addressed to "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on this 21st day of April, 2006.

CinLibrary/1608389.1